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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/840,435      | 04/23/2001  | Diana Kim Fisler     | 7105                | 4163             |

7590 01/13/2004

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EXAMINER

HOFFMANN, JOHN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1731

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/840,435

Applicant(s)

FISLER ET AL.

Examiner

John Hoffmann

Art Unit

1731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

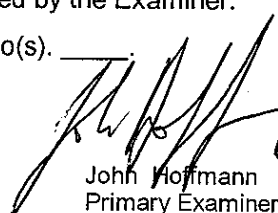
Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: \_\_\_\_\_

  
John Hoffmann  
Primary Examiner  
Art Unit: 1731

01-05-04

Continuation of 5. does NOT place the application in condition for allowance because: It is argued that Ikeda teaches away from the claimed invention. This is not persuasive for the same reasons given in the Final rejection.

It is further argued that "consisting essentially of" is defined at page 18 of the specifications. The definition of the phrase is well settled case law. Applicant is not permitted to redefine any terms to be repugnant to accepted usage.

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)

Applicant has not demonstrated that zirconia materially affects the basic and novel characteristic(s) of the claimed invention. Therefore applicant has not properly rebutted the prima facie showing of obviousness.

Various arguments regarding the specific embodiments that Ikeda mentions. This is not very relevant, because the prima facie showing of obvious was based on the broad teachings of Ikeda, not the narrow embodiments.

Examiner disagrees with the assertions that the prior art preferred embodiments constitute a teaching away from the present. The Ikeda and De Morengo patents are presumed valid; therefore all claimed inventions of Ikeda are presumed to be enabled and capable of performing as disclosed. Applicant's allegations (that the Ikeda's and De Morengo's ranges are not workable or don't possess the advantages that Ikeda and De Morengo disclosed) are irrelevant without substantive proof.

It is further argued that the prior art does not disclose any embodiments with the same composition as applicant's. The claims were rejected under 35 USC 103. There is no assertion of anticipation. Therefore the PTO need not show an exact same compositions, a showing of obviousness is sufficient to deny the granting of patent rights.

Applicant has failed to address the most relevant argument: that the claims are product by process and that the composition of the claims need not be the final resultant composition. One looking at the prior art fibers could not tell what starting compositions were used to make the final composition. Since Applicant has not argued this point, it is deemed that Applicant agrees that such demonstrates that the invention is obvious.